

Applicant : Eric A. Schon
U.S. Serial No.: Not Yet Known
Filed : Herewith
Page 17

REMARKS

This application is a continuation of U.S. Serial No. 09/100,707 (the "'707 application"). An appeal brief was originally due on November 28, 2001 in connection with the '707 application. Applicant is filing a petition for a three-month extension of time, concurrently herewith, for filing the appeal brief. Accordingly, the '707 application is pending today and this continuation application is being timely filed.

Amendments

By this Preliminary Amendment, applicant has amended the specification to incorporate a reference to the prosecution history of this application. Applicant has also canceled claims 1-89 without prejudice, and has added new claims 90-163. Accordingly, claims 90-163 are pending in the subject application.

Support for new claim 90 is found in the specification at, *inter alia*, page 5, lines 3-19. Support for new claims 91-96 is found in the specification at, *inter alia*, page 5, lines 21-24. Support for new claim 98 is found in the specification at, *inter alia*, page 5, lines 28-34. Support for new claim 99 is found in the specification at, *inter alia*, page 6, lines 16-22. Support for new claims 100-101 is found in the specification at, *inter alia*, page 6, lines 25-29. Support for new claims 102-105 is found in the specification at, *inter alia*, page 6, lines 31-35.

Applicant : Eric A. Schon
U.S. Serial No.: Not Yet Known
Filed : Herewith
Page 18

Support for new claim 106 is found in the specification at, *inter alia*, page 6, line 35 and page 7, lines 1-2. Support for new claim 107 is found in the specification at, *inter alia*, page 7, lines 1-2. Support for new claims 108-114 is found in the specification at, *inter alia*, page 7, lines 2-7. Support for new claims 115-153 is found, *inter alia*, in claims 29-67 as filed, respectively. Support for new claim 154 is found in the specification at, *inter alia*, page 5, lines 1-24. Support for new claim 155 is found in the specification at, *inter alia*, page 5, lines 9-13. Support for new claim 156 is found in the specification at, *inter alia*, page 5, lines 21-24. Support for new claim 157 is found in the specification at, *inter alia*, page 6, lines 16-20. Support for new claim 158 is found in the specification at, *inter alia*, page 6, lines 1-7. Support for new claims 159-160 is found in the specification at, *inter alia*, page 6, line 35 and page 7, lines 1-2. Support for new claim 161 is found in the specification at, *inter alia*, page 5, lines 15-19. Support for new claim 162 is found in the specification at, *inter alia*, page 7, lines 19-35. Support for new claim 163 is found in the specification at, *inter alia*, page 6, line 35 and page 7, lines 1-17.

Applicant maintains that the introduction of new claims 90-163 does not raise an issue of new matter.

Information Disclosure Statement

In accordance with his duty of disclosure under 37 C.F.R. §1.56,

Applicant : Eric A. Schon
U.S. Serial No.: Not Yet Known
Filed : Herewith
Page 19

applicant directs the Examiner's attention to the following references which are listed on the PTO-1449 form attached hereto as **Exhibit A**.

Copies of the references listed below are not being submitted, as the references may be found in priority applications U.S. Serial No. 08/409,644, filed March 24, 1995, and U.S. Serial No. 08/853,000, filed May 8, 1997.

1. U.S. Patent Serial No. 5,971,124, issued to Kumar on June 15, 1999;
2. U.S. Patent Serial No. 5,871,921, issued to Landergen et al. on February 16, 1999;
3. U.S. Patent Serial No. 5,866,337, issued to Schon on February 2, 1999;
4. U.S. Patent Serial No. 5,795,714, issued to Cantor et al. on August 18, 1998;
5. U.S. Patent Serial No. 5,656,462, issued to Keller et al. on April 12, 1997;
6. U.S. Patent Serial No. 5,506,212, issued to Hoke et al. on April 9, 1996;
7. U.S. Patent Serial No. 4,959,312, issued to Sirotkin September 25, 1990;

Applicant : Eric A. Schon
U.S. Serial No.: Not Yet Known
Filed : Herewith
Page 20

8. PCT International Application No. WO 92/17484, Kool, E.T.
March 26, 1992;
9. PCT International Application No. WO 95/22623, Landegren et
al. (PCT/SE) September 24, 1995;
10. Blanks, R. and McLaughlin, L.W. (1988) An
oligodeoxynucleotide affinity column for the isolation of
sequence specific DNA binding proteins. *Nuc. Acids Res.*
16(21):10283-10299;
11. Boland, C.R., et al., Microallelotyping defines the
sequence and tempo of allelic losses at tumor suppressor
gene loci during colorectal cancer progression, Nature
Medicine, 1(9):902-909, 09/1995;
12. Eldadh, Z. A., et al., Marfan syndrome as a paradigm for
transcript-targeted preimplantation diagnosis of
heterozygous mutations, Nature Medicine, 1(8):798-803,
08/1995;
13. Gingeras, T.R., Kwoh, D.Y. and Davis, G.R. (1987)
Hybridization properties of immobilized nucleic acids. *Nuc.*
Acids Res. 15(13):5373-5390;
14. Goto, Y., Nonaka, I. and Horai, S. (1990) A mutation in the
tRNA^{Leu(UUR)} gene associated with the MELAS subgroup of
mitochondrial encephalomyopathies. *Nature* 348:651-653;

Applicant : Eric A. Schon
U.S. Serial No.: Not Yet Known
Filed : Herewith
Page 21

15. Khudyakov, Y.E., Gaur, L., Singh, J., Patel, P. and Fields, H.A. (April 1994) Primer specific solid-phase detection of PCR products. *Nuc. Acids Res.* 22(7):1320-1321);
16. Kohsaka, H., Taniguchi, A., Richman, D.D. and Carson, D.A. (1993) Microtiter format gene quantification by covalent capture of competitive PCR products: application to HIV-1 detection. *Nuc. Acids Res.* 21(15):3469-3472;
17. Langer et al, (1981) "Enzymatic synthesis of biotin-labeled polynucleotides: Novel nucleic acid affinity probes", *Proc. Natl. Acad. Sci.* 78(11):6633-6637;
18. Lee, L.G., Connell, C.R. and Bloch, W. (1993) Allelic discrimination by nick-translation PCR with fluorogenic probes. *Nuc. Acids Res.* 21(16):3761-3766;
19. Maskos, U. and Southern, E.M. (1993) A novel method for the parallel analysis of multiple mutations in multiple samples. *Nuc. Acids Res.* 21(9):2269-2270;
20. Matthews, (1988), Analytical Strategies for use of DNA probes, *Anal. Biochem.* 169: 1-25;
21. Miller, A. D., Human gene therapy comes of age, Nature, 357:455-460, 06/1992;
22. Miller, Jo, DNA damage, p53 and anticancer therapies,

Applicant : Eric A. Schon
U.S. Serial No.: Not Yet Known
Filed : Herewith
Page 22

Nature Medicine, 1(9):879-880, 09/1995;

23. Nikiforov, T.T., Rendle, R.B., Goelet, P., Rogers, Y., Kotewicz, M.L., Anderson, S., Trainor, G.L. and Knapp, M.R. (September 1994) Genetic Bit Analysis: a solid phase method for typing single nucleotide polymorphisms. *Nuc. Acids Res.* **22(20)**:4167-4175;
24. Nilsson, M., Malmgren, H., Samiotaki, M., Kwiatkowski, M., Chowdhary, B.P. and Landegren, U. (September 1994) Padlock Probes: Circularizing Oligonucleotides for Localized DNA Detection. *Science* 265:2085-2088;
25. Offit, K., Rearrangement of the bcl-6 gene as a prognostic marker in diffuse large-cell lymphoma, The New England Journal of Medicine, 331(2):74-75 07/1994;
26. Peffer, N.J., Hanvey, J.C., Bisi, J.E., Thomson, S.A., Hassman, C.F., Noble, S.A. and Babiss, L.E. (1993) Strand-invasion of duplex DNA by peptide nucleic acid oligomers. *Proc. Natl. Acad. Sci. U.S.A.* 90:10648-10652;
27. Rabbitts, T.H., Chromosomal translocations in human cancer, Nature, 372:143-149, 11/1994;
28. Stein et al. (1988). Oligodeoxynucleotides as inhibitors of gene expression: a review. *Cancer Research* 48:2659-2668;
29. Strauss, M. et al., Unrestricted cell cycling and cancer,

Applicant : Eric A. Schon
U.S. Serial No.: Not Yet Known
Filed : Herewith
Page 23

Nature Medicine, 1(12):1245-1246, 12/1995;

30. Stratagene Catalog (1988), page 39;
31. Targan, S. R. and Murphy, L. K., Clarifying the causes of Crohn's, Nature Medicine, 1(12):1241-1243, 12/1995;
32. Wasco, W. et al., Familial Alzheimer's chromosome 14 mutations, Nature Medicine, 1(9):848, 09/1995;
33. Welcher et al.(1986), "selective enrichment of specific DNA, cDNA, and RNA sequences using biotinylated probes, avidin and copper chelate agarose", Nucleic Acids Research 14(24):10027-10044;
34. Wittung, P., Nielsen, P.E., Buchardt, O., Egholm, M. and Norden, B. (April 1994) DNA-like double helix formed by peptide nucleic acid. Nature 368:561-563;
35. Wu D.Y. and Wallace, R.B. (1989) Specificity of the nick-closing activity of bacteriophage T4 DNA ligase. Gene 76:245-254.
36. Zhou, H., Fisher, R.J. and Papas, T.S. (1993) Universal immuno-PCR for ultra-sensitive target protein detection. Nuc. Acids Res. 21:6038-6039.

Applicant requests that the Examiner review the publications and make them of record in the subject application.

Applicant : Eric A. Schon
U.S. Serial No.: Not Yet Known
Filed : Herewith
Page 24

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorneys invites Examiner to telephone at the number provided below.

No fee, other than the enclosed \$1164.00 application fee, is deemed necessary. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Alan J. Morrison
Registration No. 39,377
Attorneys for Applicant
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

2025 RELEASE UNDER E.O. 14176